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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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21839 7590 11/29/2001

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EXAMINER

HENDRICKSON, STUART L

ART UNIT	PAPER NUMBER
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1754

DATE MAILED: 11/29/2001

29

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

765901

Applicant(s)

Prot

Examiner

W. H. Johnson

Group Art Unit

1754

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 9/12/01

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 22-46 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 22-46 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 32-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) The claims recite 'comprising', which appears to contradict the 'consisting essentially of' in independent claim 31. Clarification is requested.

Claims 22-37 and 39-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chevallier et al. '570.

This is the same rejection as in paper no. 20, incorporated herein by reference. The 'consisting essentially of' phrase only excludes those things recited in the specification to be excluded; In re Janakirama-Rao 137 USPQ 893. Thus, the features of the reference are not excluded.

Claims 38 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chevallier et al. '570 as applied to claims 22-37 and 39-45 above, and further in view of Cox et al.

This is the same rejection as in paper no. 20, incorporated herein by reference. The 'consisting essentially of' phrase only excludes those things recited in the specification to be excluded; In re Janakirama-Rao 137 USPQ 893. Thus, the features of the reference are not excluded.

Applicant's arguments filed 9/12/2001 have been fully considered but are not persuasive.

The added language is not sufficient for patentability, as noted above. The Declarations were addressed previously; no new data has been added so the previous comments still apply. See

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paper 20 of 5/22/00. On pg. 7 it is argued that the deagglomeration times of 5 and 10 minutes are different from 7 minutes. Ideally however, the deagglomeration times should be identical between the two processes to show that it is the materials added (or not added) which account for any differences. On pg. 9 it is argued that the Office has not proven the properties of the reference, however it is noted that it lacks the facilities to do so. The alternate interpretation of 'consisting essentially of' is also noted but is not persuasive as it has not been adopted in the Office Action, especially in view of the inconsistency between claim 31 and those dependent thereon. On pgs. 10-12 it is argued that deagglomeration and disintegration are very different, however this is not persuasive, as both result in a finely divided material. In view of the similarities between Chevallier and the the present application (of the same assignee), it appears that the same result is achieved in each case. On pg. 14 mention is made of a May 11, 2001 Declaration. This is not present; perhaps it is an erroneous reference to the March 15, 2000 paper repeatedly argued and already addressed in previous papers. To repeat, Chevallier column 11 uses essentially the same deagglomeration technique as specification pg. 11. Thus, the results are deemed to be the same. No differences in the viscosity have been shown. The claims do not exclude the step of adding a deagglomerating agent, and a reference which sprays clearly would deagglomerate to avoid plugging problems.

The further rejection of claims using Cox is deemed proper, as an adequate motivation has been given (purification), consistent with what the references teach.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number (703) 308-2539.

A handwritten signature in black ink, appearing to read 'Stuart Hendrickson', is positioned above the printed name.

Stuart Hendrickson
examiner Art Unit 1754